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KONRAD RAYNES VICTOR & MANN, LLP
315 SOUTH BEVERLY DRIVE
SUITE 210
BEVERLY HILLS, CA 90212

EXAMINER

ALI, MOHAMMAD

ART UNIT

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 19

Application Number: 09/388,261
Filing Date: August 31, 1999
Appellant(s): NAGDA ET AL.

MAILED

APR 20 2003

Technology Center 2100

David Victor, Reg. No. 39,867
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 14, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-32 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|-----------|----------|---------|
| 5,717,923 | DEDRICK | 2-1998 |
| 5,555,496 | TACKBARY | 09-1996 |

(10) *Grounds of Rejection*

Art Unit: 2177

The following ground(s) of rejection are applicable to the appealed claims:

Claims rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 9.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

" A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

If this application currently names joint inventors, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary in considering patentability of the claims under 35 U.S.C. § 103. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

2. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,717,923 issued to Rick Dedrick et al. ("Dedrick") in view of US Patent 5,555,496 issued to Tackbary et al. ("Tackbary").
3. Dedrick renders obvious independent claim 1 by the following:
generating customer a record in a first database table to include fields specifying at least one product, customer preferences, and a selected output method to generated output material on the product specified in the customer record (Figs. 2-3, col. 15 lines 45-57, col. 6 lines 34-52) ;
receiving at least one customer record in the first database to process (col. 16 lines 27-30);
accessing at least one content file (Fig. 3) by querying a second database table (Fig. 3) using values in one received customer record (Fig. 3, col. 16 lines 23-32, Abstract);
generating the content,...., material (Fig. 2-3, col. 1 lines 22-42);

determining a selected one of a plurality from the customer record (col. 2 lines 3-24); and transmitting the output material to the customer specified in the customer record (col. 2 lines 3-24, col. 16 lines 27-30).

Dedrick does not explicitly teaches the delivery options in respect to the customer.

Tackbary does teaches delivery options in respect to the customer at (col. 9 lines 7-15, col. 1 lines 10 to col. 2 lines 67, Figs. 1, 5).

Thus it would have been obvious to one ordinary skilled in art at the time of the invention was made to add the delivery options in customer preferences of Tackbary in the customer record database and content file of Dedrick in order to improve the delivery options from the customer preferences in the combines system (col. 9 lines 7-15, col. 1 lines 10 to col. 2 lines 67, Figs. 1, 5, Tackbary).

4. Claims 12 and 22 have same subject matter as of claim 1 and essentially rejected for the same reasons.
5. As to claims 2, 13, and 23, the records in the first database are generated by a human operator interacting with a customer to determine customer and preferences (col. 2 lines 2-15, col. 5 lines 34-46).
6. As to claims 3, 14 and 24, generating the customer records comprises executing a mining program against a database including customer information to determine information to populate at least one customer record from the customer (col.1 lines 37 to col. 2 lines 15).
7. As to claims 4, 15 and 25, members of the set consisting (Abstract, col. 6 lines 33-52)
8. As to claim 5, 16 and 26, automatically transforming the output material to a format compatible,...., wherein the transformed output is transmitted to the customer (col.1 lines 37 to col. 2 lines 15, col. 6 lines 33-52).
9. As to claims 6, 17 and 27, multiple customer records are processed, and wherein the output generated from the customer records differs for at least two customers used to transmit the output differs for at least two customers (col.1 lines 37 to col. 2 lines 15, col. 16 lines 27-30).

10. As to claim 7, 18, and 28, the output material is automatically transmitted using, after generating the output material,..., address (col.1 lines 37 to col. 2 lines 15, col. 6 lines 47-52, Abstract).
11. As to claims 8, 19, and 29, processing a template including queries of records in the second database table (col.1 lines 37 to col. 2 lines 15, col. 14 lines 55-64);
accessing at least one value in a field in one customer record to include in a query against the second database table (col.1 lines 37 to col. 2 lines 15, col. 14 lines 55-64); and
applying the query against the second database to determine a record associated with a file including fields matching the query, wherein the accessed file is associated with the determined record, and wherein generating the content into the output material comprises generating the content into the template, which forms the output material (col.1 lines 37 to col. 2 lines 15, col. 14 lines 55-64).
12. As to claims 8, 19, and 29, Official Notice is given that processing a template is well known in the art at the time of the invention. Thus, it would have been obvious to one ordinary skilled in the art at the time of the invention to process a template in order to be record in the database.
13. As to claims 9, 20, and 30, there are multiple files for each query, wherein the records (col. 16 lines 27-30) associated with the files for each query (col. 14 lines 55-64) have different values in at least one field, wherein determining the record comprises determining the record from the files associated with the query that matches the search criteria (col.1 lines 37 to col. 2 lines 15).
14. As to claims 10, 21, and 31, each query is maintained in a container in the template, wherein the file having the associated record that matches the query (col. 14 lines 55-64) is generated into the container, further comprising resizing the appearance of the file content generated into the containers in the output material (col.1 lines 37 to col. 2 lines 15).
15. As to claim 11 and 32, data from the customer record to insert into the text generated into the container from the accessed file generated into the container (col.1 lines 37 to col. 2 lines 15).

(11) Response to Argument

I. Response to Appellant's Argument Regarding in Group I that Dedrick and Tackbary Fail to Disclose "at least one content file by querying a second database table using values received in one customer record in a first database table, and then generating the content of each accessed file in the received output material".

Appellant argues that the references fail to teach accessing at least one content file by querying a second database table using values from a customer record. The Examiner respectfully disagrees with Appellant's interpretation of the references. Appellant's claim 1 calls for the step of "at least one content file by querying a second database table using values received in one customer record in a first database table, and then generating the content of each accessed file in the received output material". Pursuant to Appellant's specification (see page 2, lines 18-24 et seq), a customer record in first database table is interactively generated to include fields specifying at least one product, product demands, product preferences, and selected output method to deliver output material on the product specified customer record. At least received one customer record from the first database table accessing at least one content file process the second database. The content file of each accessed file is then generated into the output material. Similarly, Dedrick discloses a distributed network in a client system access the user profile data (first database) for the end user from the personal database (second database) to determine the search criteria (query) for this end user, and then proceeds to work its way back through the system to locate the electronic content information which matches the search criteria and generate the output (see col.

8, lines 27-31, Fig. 1 et seq). The claimed accessing at least one content file by querying a second database table hence very analogous to Sherman teaching of accessing at least one content file by querying a second database table. Although Dedrick discloses the profile data (first database) and personal database (second database) for generating the content of accessed file, the claimed step of first database and second database and Derick's teaching of first database and second database are functional equivalents. Alternatively, it would have been obvious to one ordinary skill in the art for accessing at least one content file to modify Derick's teaching by first database record and second database record in the content information, as claimed. Such modification would allow user's to access of Dedrick's system to achieve more flexibility for first and second database record.

II. Tackbary teaches the delivery options for outputting material.

Appellant contends that the Dedrick-Tackbary combinations do not teaches the step of delivery options for output material. The Examiner respectfully disagrees with such contention. Pursuant to Appellant's specification (see page 7, lines 8-10 et seq), upon selecting delivery method, the program would prompt the user to enter customer address information for the delivery method, e.g., e-mail address, fax number, street address, etc. In column 9, lines 7-15, and Fig. 5, Tackbary teaches a mail mode box displayed within the card event dialog box allows the user to chose the method by which card is to be sent, considering the delivery options, such as by Federal Express®, United States Mail, or Overnight Delivery etc. Therefore the claimed step of delivery options reads the cited portions of Tackbary.

In the event that honorable Board of Appeals finds that Dedrick inadequately discloses the claimed step of delivery options, the Tackbary should remedy such deficiency. Tackbary discloses an analogous system to Dedrick's that complements the latter by providing the user selected delivery options that allows generating output material to be send (col. 9, lines 7-15, Fig. 5). Consequently, it would have been obvious to one ordinary skill in the art of delivery material to combine the teachings of the cited references since Tacbary's teaching of delivery options that would allow of Dedrick's system generated output material.

III. Dedrick and Tackbary can be properly combined to yield the claimed invention since they are analogous art and Tackbary complements Dedrick.

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dedrick is directed to a method accessing in the content file and generate the output, Tackbary is directed to method for delivery the generated output by user selected options. Because the two references are concerned with the solution to problem of interactive network system to access the file resources, there is an implicit motivation to combine these references. In other words, the ordinary skilled artisan, during his/her quest for a

solution to the cited problem, would look to the cited references at the time the invention was made. Consequent, the ordinary skilled artisan, would have been motivated to combine the cited references since Tackbary's teaching would enable to users delivery options of Dedrick's system from the content file.

IV. Response to Appellant's Argument Regarding in Group II that Dedrick and Tackbary Fail to Disclose "customer information to determine information to populate at least one customer record from the customer and customer information add to a customer record".

Appellant argues that the references fail to teach customer information to determine information to populate at least one customer record from the customer. Examiner respectfully disagrees with Appellant's interpretation of the references. Similarly, Dedrick discloses a distributed network in a client system accessing to the content file with first database and second database as stated above, the record information will be displayed (populate) like as credit card numbers, social security numbers, mailing addresses, preferred shipping methods etc. for individual to facilitate ordering (see col. 5, lines 54-59 et seq). Further, Dedrick discloses additional information is added to the customer profile database (see col. 6, lines 58-59 et seq). The claimed populate customer record information and add customer record hence very similar to Dedrick's teaching of populate customer record information and add customer record.

V. Response to Appellant's Argument Regarding in Group III that Dedrick and Tackbary Fail to Disclose "template include queries records in the second

database table, and that file is accessed using values in one customer record from the first database table by applying the query having the value from the customer record against the second table to determine a record associated with a file, such that accessed file generated into the content is associated with determined record.”

Appellant argues that the references fail to teach content from the file is generated into the template. Examiner respectfully disagrees with Appellant's interpretation of the references. Pursuant to Appellant's specification (see page 7, lines 24-28, Fig. 1 et seq), a template is comprised of containers, which are sections into which files from the content database 8 are inserted. Each of the files in the content database 8 include metadata in the form of a database record in the content database 8 that provides attributes associated with the file. Similarly, Dedrick discloses a distributed network in a client system accessing to the content file with first database and second database as stated above and content database (template) locate in the remote location and Hyper text oriented mark up language routes distributed end users and allow the users answer queries with advertiser to the content database (see col. 14, lines 60-62, Fig. 1 et seq). The claimed template hence very similar to Dedrick's teaching of template.

VI. Response to Appellant's Argument Regarding in Group IV that Dedrick and Tackbary Fail to Disclose “multiple content files for each query, wherein the records associated with the files have different values, such that one of the records whose values match the query determined”.

Appellant argues that the references fail to teach multiple content files for each query. Examiner respectfully disagrees with Appellant's interpretation of the references. Similarly, Dedrick discloses multiple content files (see Figs. 3-5, col. 14, lines 60-62 et seq), for each query. The claimed multiple content files for each query hence very similar to Dedrick's teaching of multiple content files for the query.

VII. Response to Appellant's Argument Regarding in Group V that Dedrick and Tackbary Fail to Disclose "query is maintained in a container in the template resizing the appearance of the file content generated into the containers in the output material".

Appellant argues that the references fail to container template and resize the appearance of the file content. Examiner respectfully disagrees with Appellant's interpretation of the references. Similarly, Dedrick discloses template associated with query as stated above and in the user profile data according to customer preference such as color preferences, favorite sizes and shapes etc. can be transferred. (see col. 3, lines 50, Fig. 1 et seq). The claimed resize appearance hence very similar to Dedrick's teaching of user preference of size.


Conclusion

The references disclose the claimed association with accessing at least one content file querying with the first database and second database and deliver the output material Dedrick provide content file associated with first and second database with output material, and Tackbary provide delivery options. Last Dedrick and Tackbary can be properly combined to yield the claimed invention since they are analogous art, and

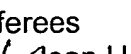

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Tacbarly further complements of Dedrick. In light of the foregoing arguments, the Examiner respectfully requests the honorable Board of Appeals and Interferences to sustain the rejection.

Respectfully submitted,


Mohammad Ali
April 16, 2003

Conferees

1.  Jean Homere, Primary Examiner, Art Unit 2177
2. Hosain Alam, Primary Examiner, Art Unit 2172 

KONRAD RAYNES & VICTOR, LLP
315 SOUTH BEVERLY DRIVE
SUITE 210
BEVERLY HILLS, CA 90212